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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,221	12/01/2003	Hiroshi Kamohara	0171-1044P	9834

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EXAMINER

PENG, KUO LIANG

ART UNIT PAPER NUMBER

1712

DATE MAILED: 11/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/724,221

Applicant(s)

KAMOHARA ET AL.

Examiner

Kuo-Liang Peng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 8/8/06 Amendment.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,5,8,12 and 20-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,8,12 and 20-35 is/are rejected.
- 7) ☒ Claim(s) 22 and 34 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The Applicants' amendment filed on August 8, 2006 is acknowledged.

Claims 3, 6-7, 9-11 and 13-19 are deleted. Claims 1 and 22 are amended. Claims 24-35 are added. Now, Claims 1-2, 4-5, 8, 12 and 20-35 are pending.

2. The text of those sections of Title 35, U.S. code not included in this action can be found in prior Office Action(s).

#### ***Claim Objections***

3. Claims 22 and 34 are objected to because of the following informalities:

In Claim 22 (line 3), before "polyether", should there be -- the --?

In Claim 34 (line 2), should "of polyether" be -- of the polyether --?

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

4. Claim 34 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 34 recites the limitation "the polyether" in line 2. There is insufficient antecedent basis for this limitation in the claim.

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 25-26, 28-33 and 34-35 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for using a silane having at least three silicon atom-bonded hydrolyzable groups per molecule or a partial hydrolytic condensate thereof (page 12, lines 27-33), does not reasonably provide enablement for using any curing agent having a hydrolyzable group. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

7. Claims 1-2, 4-5, 8, 12 and 20-35 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the

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specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Examiner is not able to find the basis for the specific amounts of diphenylsiloxane units and the methylphenylsiloxane units being based on **a whole of component (A)** set forth in the instant claims.

***Claim Rejections - 35 USC § 103***

8. Claims 1-2, 4-5, 8, 12 and 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Torto (WO 00/61074).

The following column and line numbers are based on Torto's US equivalent, US 6 762 242.

Torto discloses a dental impression composition comprising a Si-alkenyl functional polysiloxane (POS(1)), a Si-H containing polysiloxane (POS(2)) and a surfactant of polyalkylene oxide. (col. 1, lines 7-38, col. 3, line 24 to col. 4, line 3, col. 5, line 61 to col. 6, line 10 and Examples) POS(1) can comprise siloxy units of formula 1.1 and siloxy units of formula 1.2. (col. 7, line 1 to col. 8, line 56) Note that in POS(1), Z can be a methyl, ethyl or phenyl radical with as low as 60 mole% of Z being methyl radicals. (col. 7, lines 42-44) Furthermore, Z in formula 1.2 can be exemplified as **methylphenylsiloxyl, diphenylsiloxyl** and dimethylsiloxyl. (col.

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7, lines 48-50) Therefore, Torto does teach that up to 40 mole% of the Z can be a phenyl group. The amount of the surfactant is described in col. 6, lines 50-60.

For Applicants' argument (Remarks, page 11, 2<sup>nd</sup> paragraph to page 12, 1<sup>st</sup> paragraph), as mentioned above, Torto does teach that up to 40 mole% of the Z can be a phenyl group. Therefore, the ranges of the amounts of the methylphenylsiloxyl or diphenylsiloxyl units overlap with those of Applicants'. Therefore, arguing that Torto does not expect the criticality of the amounts of the specific siloxane units appears to be irrelevant.

For Applicants' argument (Remarks, page 12, 2<sup>nd</sup> paragraph), Applicants alleged, "However, Torto only shows the skilled artisan how to reduce the contact angle to 61.1 degree in Examples (see the table on column 14)". However, Torto's contact angle of 61.1 degree is merely a preferred embodiment. Certainly, taken as a whole, Torto does not teach away of any composition having even lower contact angle. Applicants further argue that Torto provides no guidance as to how a contact angle of less than 60.1 degrees. However, Examiner disagrees because Torto discloses a method of preparing a composition with low contact angles. **Unless** Applicants' can show that Torto's composition having a contact angle of up to 55 degrees is only a "wish list", the rejection appears to be proper. Especially, court held that the arguments of counsel cannot take the place of evidence in the record.

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*In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); *In re Geisler*, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997)

9. Claims 25-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nitzsche (US 3 070 566) in view of Bryan (US 4 657 959) or Chikuni.

Nitzsche in view of Bryan or Chikuni discloses a composition for dental application or building member application as described in paragraph 10 of the prior Office action (Paper No. 062505).

For Applicants' argument (Remarks, page 13, paragraph 3 to page 14, paragraph 1), Examiner disagrees. Nitzsche's hydroxy end-blocked diorganosiloxane alone reads on component A) in the instant claims. Therefore, the calculation of the amounts of diphenylsiloxane units and methylphenylsiloxane units based on the sum of Nitzsche's hydroxy end-blocked diorganosiloxane and triorganosilyl endblocked diorganosiloxane appears to be improper. It is noted that the instant claims **does not exclude** any additional component such as a triorganosilyl endblocked diorganosiloxane. Furthermore, the phrase "as a whole of component (A)" recited in the instant claims introduces **new matter**, *supra*. In addition, arguing the amounts of diphenylsiloxane units and methylphenylsiloxane

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units in Nietzsche's Examples appears to be irrelevant because they are merely preferred embodiments.

For Applicants' argument (Remarks, page 14, paragraphs 2-3), Applicants are reminded that court held that mere recognition of latent properties in the prior art does not render nonobvious an otherwise known invention. *In re Wiseman*, 596 F.2d 1019, 201 USPQ 658 (CCPA 1979)

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.



11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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klp

October 24, 2006

A handwritten signature in black ink, appearing to read 'Kuo-Liang Peng', written in a cursive style.

Kuo-Liang Peng  
Primary Examiner  
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